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**UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451**

Goodman

Mailed: April 25, 2006

Cancellation No. 92031572

LU SORO<sup>1</sup>

v.

CITIGROUP, Inc.

Before Quinn, Walters and Rogers, Administrative Trademark Judges.

By the Board:

Lu Soro (hereinafter petitioner or "Soro") seeks cancellation of Citigroup Inc.'s (hereinafter respondent or "Citigroup") registration for the mark CITIGROUP, registered for a "full range of insurance and financial services; banking services; credit card services; securities trading, consulting and underwriting services; [and] investment services" in International Class 36.<sup>2</sup>

As grounds for cancellation, Soro alleges priority of use and likelihood of confusion.

In its answer, Citigroup has denied the salient allegations in the petition to cancel and alleged certain affirmative defenses.

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<sup>1</sup> Lu Soro is also known as Luis Soro.

<sup>2</sup> Reg. No. 2406753, issued November 21, 2000, claiming October 8, 1998 as its date of first use in commerce.

On May 22, 2002, the Board suspended proceedings pending the final determination of the civil contempt action between the parties.<sup>3</sup> The civil contempt action has been finally determined, and now before the Board are petitioner's motion, filed January 4, 2006, for summary judgment on the ground of priority<sup>4</sup> and respondent's cross-motion, filed January 23, 2006, for summary judgment based on its affirmative defenses of petitioner's lack of standing and res judicata, specifically, collateral estoppel.<sup>5</sup>

Before turning to these matters, we will briefly summarize the decision in *Citicorp v. Citicorp Mortgage Co. Inc. and Luis Soro* and the decision in the subsequent contempt proceeding, issued on May 14, 2003, because it directly relates to the controversy before us, and because the parties reference the case and the findings made in the contempt proceeding in their motions for summary judgment.

On or about August 26, 1985, respondent's predecessor, Citicorp, filed a complaint in the United States District Court in the Southern District of Florida, alleging

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<sup>3</sup> *Citicorp v. Citicorp Mortgage Co. Inc. and Luis Soro*, Case No. 85-2960-CIV, United States District Court, Southern District of Florida. The civil contempt action was brought against Soro in his individual capacity.

<sup>4</sup> It is not entirely clear if Soro is moving for summary judgment on both priority and the ground of likelihood of confusion. Soro states in his one-page motion for summary judgment that he seeks summary judgment based on the district court decision giving Soro "undisputed first use with ultimate rights to Citigroup."

<sup>5</sup> The Board construes Soro's filing titled a "motion to strike respondent's motion for summary judgment" as a response in opposition thereto.

trademark infringement by Citicorp Mortgage Co., owned by Soro. The complaint was later amended on March 5, 1987 to add Luis Soro, the petitioner herein, as a defendant. On September 9, 1987 the district court granted Citicorp's motion for summary judgment and entered a permanent injunction against Citicorp Mortgage Co. and against Soro. The permanent injunction, among other things, prohibited Soro and Citicorp Mortgage Company from "using CITICORP as part of a name or mark or using any other name or mark confusingly similar to CITICORP, in connection with any business which Defendants conduct, own or control" and "holding themselves out as the owner of, or a person authorized to use CITICORP or a name confusingly similar thereto, as a service mark, trademark or tradename."

After an appeal by Soro to the Eleventh Circuit Court of Appeals, and a remand, the district court reconsidered the grant of Citicorp's motion for summary judgment as to Soro. On October 6, 1988, the district court again granted the motion for summary judgment against Soro, entering the permanent injunction against Soro, and directing Soro to "comply with the other directives contained in this Court's Summary Final Judgment dated September 8, 1987." On April 3, 2002, Citigroup, respondent herein and successor in interest to Citicorp, filed a motion in the district court of the Southern District of Florida to find Soro in contempt

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of court for violation of the permanent injunction entered on October 7, 1988, based on Soro's use of the names and marks "Citigroup" and "Citicorp." On May 14, 2003, the district court issued an order granting the contempt motion based on a finding that Soro had violated the permanent injunction. The district court, in adopting the magistrate's report and recommendation, ruled that Soro violated the permanent injunction and found, among other things, that Soro has been using the name Citigroup "since at least the mid-1990s"; that "'Citigroup' is confusingly similarly [sic] to 'Citicorp'"; that "use of the term 'CITI' as part of 'Citigroup Mortgage Company' is confusingly similar to and not a safe distance from the world-famous 'Citicorp' mark, and therefore, violates the Injunction"; and that Soro violated the injunction because he "did not keep a 'safe distance' from the name 'Citicorp' when he used the name 'Citigroup Mortgage Company.'" The Court ordered Soro to "immediately cease and desist from using the Citigroup name."

We now turn to Citigroup's motion for summary judgment.

Citigroup contends that in view of the district court decision in *Citicorp v. Citicorp Mortgage Co. and Luis Soro* and the decision in the subsequent contempt proceeding, Soro has been held to have no rights in the

mark CITIGROUP, and therefore, Soro lacks standing to bring the cancellation proceeding before the Board. Citigroup further argues that even if Soro is found to have standing, he is collaterally estopped from bringing the cancellation due to the district court's finding in Butthe contempt proceeding that Soro did not have priority of use of the CITIGROUP mark and that Soro's use of the CITIGROUP mark was confusingly similar to Citigroup's CITI marks.<sup>6</sup>

In response, Soro argues that the district court found that Soro, not Citigroup, has priority.<sup>7</sup>

Summary judgment is an appropriate method of disposing of cases in which there is no genuine issue of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating the absence of any genuine issue of material

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<sup>6</sup> As evidence, respondent has provided a declaration of its counsel, Kenneth Plevan, with accompanying exhibits which include the following: September 9, 1987 district court order granting Citicorp's motion for summary judgment on the ground of trademark infringement and entry of permanent injunction against Citicorp Mortgage Co. and Soro; October 6, 1988, motion for summary judgment and subsequent opinion (after remand from Eleventh Circuit court of appeals) granting Citicorp's motion for summary judgment and entering permanent injunction against Soro; March 26, 2003 magistrate's Report and Recommendation recommending Citicorp's motion for contempt be granted; and May 14, 2003 district court opinion granting Citicorp's contempt motion for Soro's violation of permanent injunction.

<sup>7</sup> Soro's arguments are directed to the issue of priority of use rather than standing, which requires a showing of a real interest to bring this proceeding.

fact. See *Celotex Corp. V. Catrett*, 477 U.S. 317, 322-324 (1986). The evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993). If the party moving for summary judgment carries its initial burden, and the nonmoving party fails to make a sufficient showing on an essential element of its case with respect to which it would have the burden of proof at trial, judgment as a matter of law may be entered in favor of the moving party. See Fed. R. Civ. P. 56(c); *Fram Trak Industries Inc. v. WireTracks LLC*, 77 USPQ2d 2000, 2004 (TTAB 2006) (citing *Celotex Corp, supra*).

Because standing is a threshold issue that must be proven by a plaintiff in every inter partes case, *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999) and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982), we turn first to the question of whether respondent has shown that there is no genuine issue of material fact as to Soro's lack of standing to bring this cancellation proceeding.

The purpose of the standing requirement, which is directed solely to the interest of the plaintiff, is to prevent litigation when there is no real controversy

between the parties. *Lipton Industries, Inc.*, 213 USPQ at 189. In the case of a petition to cancel, the standing requirement of a plaintiff has its statutory basis in Section 14 of the Act which provides that "any person who believes he is or will be damaged . . . by the registration of a mark on the principal register . . ." may file a petition to cancel.

To establish standing, it must be shown that the plaintiff has a "real interest" in the outcome of a proceeding; that is, plaintiff must have a direct and personal stake in the outcome of the cancellation. *Ritchie*, 50 USPQ2d at 1023. Facts regarding the legitimate personal interest are a part of the plaintiff's case and must be proved. *Lipton Industries*, 213 USPQ at 189.

With regard to a Section 2(d) claim under 15 U.S.C. Section 1052(d) of the Trademark Act, Soro, at trial, would need to show that he has a real commercial interest in the CITIGROUP mark or trade name, plus a reasonable basis for his belief that he would be damaged by the CITIGROUP registration to establish standing. *Chemical New York Corp. v. Conmar Form Systems, Inc.*, 1 USPQ2d 1139, 1142 (TTAB 1986). When pleading allegations relative to standing, the plaintiff's belief in damage must have some reasonable basis in fact. *Universal Oil*

*Products Co. v. Rexall Drug and Chemical Co.*, 463 F.2d 1122, 174 USPQ 458, 459-60 (CCPA 1972).

In this case, we find that there is no genuine issue of material fact that Soro lacks a legitimate commercial interest in the CITIGROUP mark and that, as a result, his belief in damage resulting from an alleged likelihood of confusion between his asserted mark and respondent's mark is wholly without merit. Under the terms of the permanent injunction, Soro and his company cannot establish that he has a right to use the CITIGROUP mark or trade name as he and his company are permanently enjoined from "using CITICORP as part of a name or mark or using any other name or mark confusingly similar to CITICORP, in connection with any business which Defendants conduct, own or control" and "holding themselves out as the owner of, or a person authorized to use CITICORP or a name confusing similar thereto, as a service mark, trademark or tradename." The district court decision in the contempt proceeding established that any use by Soro of the mark or trade name CITIGROUP violates the terms of the permanent injunction because CITIGROUP is "confusingly similar to and not a safe distance from the world-famous 'Citicorp' mark." Therefore, we find that there is no genuine issue of material fact that Soro is prohibited by the terms of the permanent injunction from using Citicorp or any mark



or trade name confusingly similar, which includes the mark or trade name "Citigroup."<sup>8</sup> As a result, under the terms of the permanent injunction, Soro, as a matter of law, has no standing to maintain this proceeding because he lacks a legitimate commercial interest in the CITIGROUP mark and cannot prevail herein. See e.g., *Coup v. Vornado Inc.*, 9 USPQ2d 1824 (TTAB 1988) (petitioner's failure to prove standing warrants grant of summary judgment for respondent).

Inasmuch as Soro is barred by the permanent injunction from use of the CITIGROUP mark, we find that there is no genuine issue of material fact as to Soro's lack of standing to bring a petition to cancel against the involved registration, and that Citigroup is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). Petitioner, as the nonmoving party in regard to Citigroup's motion, has failed to show in response thereto that there is a genuine issue for trial in regard to petitioner's standing. In view of our finding of Soro's lack of standing, we need not consider Soro's motion for summary judgment.

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<sup>8</sup> In view of our finding on the threshold issue of standing, we need not reach the merits of Citigroup's second argument regarding collateral estoppel.

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Accordingly, Citigroup's motion for summary judgment is granted on the basis of lack of standing; judgment is entered against Soro based on his lack of standing; and the petition to cancel is denied.